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09/903,388	07/09/2001	Dean Furbush	09857-061001	9349
26161	7590	12/26/2008		
FISH & RICHARDSON PC			EXAMINER	
P.O. BOX 1022			SUBRAMANIAN, NARAYANSWAMY	
MINNEAPOLIS, MN 55440-1022				
			ART UNIT	PAPER NUMBER
			3695	
			NOTIFICATION DATE	DELIVERY MODE
			12/26/2008	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

PATDOCTC@fr.com

Office Action Summary

Application No.

09/903,388

Applicant(s)

FURBUSH ET AL.

Examiner

Narayanswamy Subramanian

Art Unit

3695

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 June 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) 18-28 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17 and 29-33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
- Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. This office action is in response to applicant's communication of June 17, 2008. Amendments to claims 1-17 and 29-33 have been entered. Claims 1-33 are pending of which claims 18-28 have been withdrawn from consideration as being drawn to a non-elected invention. Applicants are respectfully requested to cancel the non-elected claims 18-28 in response to this office action. Claims 1-17 and 29-33 have been examined. The rejections and response to arguments are stated below. Applicants are requested to note the Examiner's new art unit number (**AU 3695**) in their reply to this office action.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1-17 are rejected under 35 U.S.C. 112, first paragraph, because they are drawn to a system with single means.

A single means claim, i.e., where a means recitation does not appear in combination with another recited element of means, is subject to an undue breadth rejection under 35 U.S.C. 112, first paragraph. *In re Hyatt*, 708 F.2d 712, 714-715, 218 USPQ 195, 197(Fed. Cir. 1983) (A single means claim which covered every conceivable means for achieving the stated purpose was held nonenabling for the scope of the claim because the specification disclosed at most only those means known to the inventor.). When claims depend on a recited property, a fact situation comparable to *Hyatt* is possible, where the claim covers every conceivable structure (means) for achieving the stated property (result) while the specification discloses at most only those known

to the inventor. Claims 1-17 are drawn to a system comprising a client station. Besides the client station there is no other hardware recited in the system. Claims 1-17 are in essence drawn to a system with single means. Appropriate correction is required.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claim 2 is rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential structural cooperative relationships of elements, such omission amounting to a gap between the necessary structural connections. See MPEP § 2172.01. The omitted structural cooperative relationships are: Claim 2 recite the limitation “a server system including a server process that receives the order from the client system”. It is not clear how the client station in claim 1 is related/connected/linked to the server system of claim 2. The elements relating the two structural elements are missing in claim 2. Hence the scope of the claim is not clear to one of ordinary skill in the art. A claim is considered indefinite if it does not apprise those skilled in the art of its scope. Appropriate correction is required.

Claims 1-17 and 29-33 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Independent claim 1 recites the limitation “that allows the user to choose a priority type for how the order interacts with contra side quotes/orders in the trading venue”. It is not clear as to what is the outcome of using this feature. Allowing a user to perform a function does not necessarily imply that the function is performed. Also independent claims 1 and 29 also recite the limitations “that can at least in part satisfy the order” and “how the order interacts with contra side quotes/orders in the trading venue”. It is not clear what the

applicants mean by these limitations. Specifically the metes and bounds of the limitations “satisfy the order” and “how the order interacts” are unclear. Hence the scope of the claim is not clear. Dependent claims are rejected by way of dependency on a rejected independent claim. Appropriate correction is required. Also dependent claims 2-17 and 30-33 recite limitations such as “the non-directed order”, “marketable limit order”, “Liability Order”, “priority that is strict price/time, or price/size/time, or price/time”, “non-attributable agency orders of UTP Exchanges”, “principal quotes of UTP Exchanges”, “separate quote-access fee”, “separate quote-access fee to non-subscribers” which are not clear. Appropriate correction is required for all these claims.

The art rejections below are interpreted in view of the 112, second paragraph rejections above.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-17 and 29-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over NASD Rulemaking Reference (Reference U in PTO-892 mailed March 18, 2008).

Claims 1 and 29, Reference U discloses a system for an electronic venue for trading of securities and a computer program product for an electronic trading venue for trading of securities said computer program product residing on a computer readable medium comprising

instructions for causing a computer to: receive an order entered from a client station the orders for execution against any participant that can at least in part satisfy the order (See the entire disclosure of Reference U especially pages 3, 9 and 31-38); and determine a priority type for how the order interacts with contra side quotes/orders in the trading venue (See the entire disclosure of Reference U especially pages 3, 9 and 31-38). A computer program product for performing the above steps are inherent in the disclosure as is a client station including a graphical user interface for entering an order.

In the alternative, a system for trading of securities with a client computer station including a graphical user interface for entering an order and specifying the order parameters are old and well known in the electronic trading of securities. A system with a computer program product to perform the steps of ordering and specifying the order parameters are also old and well known. These features make the ordering process time and cost efficient compared to a manual process.

Claim 2, a server system including a server process that receives the order from the client system and executes the order against interest in the trading venue based on the priority type user chosen by the user is implied by the disclosure of Reference U. In the alternative, a server system including a server process that receives the order from the client system and executes the order against interest in the trading venue based on the priority type user chosen by the user is old and well known. These features make the execution of orders time and cost efficient and less prone to error compared to a manual process.

Claims 3-17 and 30-33 the features in these claims are taught by the disclosure of Reference U.

Response to Arguments

8. In response to Applicant's arguments "A person of ordinary skill in the art would be able to determine the scope of the claims, and if need the person skilled in the art can consult Applicant's specification and the recited claim language for additional guidance", the Examiner respectfully disagrees. The Examiner would like to respectfully point out that claims must particularly point out and distinctly claim the invention. The primary purpose of this requirement of definiteness of claim language is to ensure that the scope of the claims is clear so the public is informed of the boundaries of what constitutes infringement of the patent. (See MPEP 2173). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

In response to Applicant's arguments "As discussed above, the elements of claim 2 are not required to directly functionally relate or directly inter-cooperate. However, a person of ordinary skill in the art would be able to identify the typical server-client relationship currently recited in claim 2. Furthermore, Applicants' specification describes that "the electronic market includes client systems 12 that access a central quote/order collector facility ...comprised of one or preferably a plurality of server computers", the Examiner respectfully disagrees. As discussed in the rejection, it is not clear how the client station in claim 1 is related/connected/linked to the server system of claim 2. The elements relating the two structural elements are missing in claim 2. Hence the scope of the claim is not clear to one of ordinary skill in the art. A claim is considered indefinite if it does not apprise those skilled in the art of its scope. Claims must particularly point out and distinctly claim the invention. The primary purpose of this requirement

of definiteness of claim language is to ensure that the scope of the claims is clear so the public is informed of the boundaries of what constitutes infringement of the patent. (See MPEP 2173).

Applicant's other arguments have been fully considered but they are either moot or not persuasive.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure are listed on the attached form PTO-892.

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Narayanswamy Subramanian whose telephone number is (571) 272-6751. The examiner can normally be reached Monday-Thursday from 8:30 AM to 7:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor,

Charles R. Kyle can be reached at (571) 272-6746. The fax number for Formal or Official faxes and Draft to the Patent Office is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PMR or Public PAIR. Status information for unpublished applications is available through Private PMR only. For more information about the PMR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Narayanswamy Subramanian/
Primary Examiner
Art Unit 3695

November 1, 2008